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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/406,001	09/24/99	HIATT, JR.	A HTT-9901

WM02/0313  
LAW OFFICE OF DALE B. HALLING  
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EXAMINER

CRAVER, C

ART UNIT

PAPER NUMBER

2681

DATE MAILED: 03/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/406,001

Applicant(s)  
Hiatt, Jr.

Examiner  
Charles Craver

Group Art Unit  
2681



☒ Responsive to communication(s) filed on Jan 12, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on 1-12-01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/406,001 is acceptable and a CPA has been established. An action on the CPA follows.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
4. Claim 1 recites "a computer connected to the wireline communication network, the computer containing an address software that is capable of extracting a plurality of addresses in an address database and sending the plurality of addresses to the portable wireless electronic device, storing the plurality of addresses in the address database of the portable wireless electronic device...". Said recitation strongly implies that the storage of the data at the wireless device is

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performed by the software at the computer, even though said storage would be inherently performed by hardware and software at the user portable device. A thorough reading of applicant's disclosure has only shown that it is in fact the wireless device which performs the storage, see spec. page 6 lines 20-22.

### ***Claim Objections***

5. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 12 recites a transfer of information from a first device to a second device, which is already recited in limitation (d) of the claim from which it depends.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-14, 16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al, of record, in view of "User Profiles and Information Services" and "How to Copy the PAB to Another Computer", Microsoft publications Q162203 and Q169709.

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**Regarding claim 1,**

Pepe discloses a system for transferring data comprising:

a portable wireless device (30, col 1 lines 36-41)

a wireless communication system (54) capable of establishing a wireless communication link with the device

a wireline network (49) connected to the wireless network (see FIG 4)

a computer (22, see FIG 1) connected to the wireline network, the computer capable of sending data to the wireless device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), the computer inherently using software. Further, since the data may be in email format (col 3 lines 48-56), it is assumed that the data may comprise any information a user wishes to transfer, including but not limited to text, files, or a plurality of addresses. Lastly, the computer is not a part of the wireline or wireless networks (see FIGS 1 and 4).

Pepe does not specifically disclose that the portable device and the computer have address databases, and that the portable device stores the received addresses in its address database.

Microsoft discloses an email program well known in the art at the time of the invention and used in both wireline computers (i.e. the computer of claim 1) and notebook computers (i.e. the portable device) which comprises an address database, and wherein a user may copy information from a file (receivable from e.g. an email) and insert it into their address database (page 6 lines 2-20, page 8 line 1-page 10 line 17). As such, such software may be utilized by the system of Pepe; for example, the computer may send an address book file via email through the

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network of Pepe to the wireless user, who may then insert the address book including the addresses therein into their email program, inherently storing said addresses in said address database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to the email network of Pepe, as it would allow the use of popular email software used by a very large percentage of world email users on said portable device, for example Microsoft Outlook.

**Regarding claim 2,**

Pepe discloses that said wireless device is a cellular device (col 1 lines 36-41).

**Regarding claim 3,**

As shown above, Pepe discloses applicants invention of claim 1. However, Pepe does not specifically disclose that said network operates under a digital PCS wide area network protocol. However, such a feature was well known in the art at the time of the invention, and as such the examiner takes Official Notice of such a feature. It would have been obvious, noting Pepe's disclosure that the user may comprise a cellular terminal, that such a memory transfer method may be applied to a PCS wide area network, as it would allow the invention of Pepe to operate on new communication systems and standards.

**Regarding claim 4,**

While disclosing all of the limitations set forth in claim 1 as shown above, Pepe does not specifically recite that said network may operate according to a hypertext protocol. However,

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given that Pepe does disclose thus use of internet and email protocol (col 5 lines 5-13), it would have been obvious to one skilled in the art at the time of the invention to utilize HTTP as it is a common internet protocol for transferring data.

**Regarding claim 5,**

Pepe teaches that the invention may utilize the internet (col 23 lines 40-46) and uses email as a messaging standard (col 3 lines 48-56, col 11 lines 3-6).

**Regarding claims 6-9,**

Pepe discloses a PDA which would inherently contain a program for transferring the data. As for claims 7-9, since Pepe teaches a PDA which may send email to the computer (col 10 line 63-col 11 line 6), a situation in which a PDA user sends an email using said software requesting, for example, a telephone number, file, or selected addresses would read on claims 7-9.

**Regarding claims 10 and 12,**

Pepe discloses a method for transferring information comprising  
at a first electronic device (computer 22, see FIG 1) connected to a combined wireline (54) and wireless (49) network (FIG 4), setting up a communication path between it and a second device (30) connected to said networks (col 5 lines 14-40 see FIG 3), inherently comprising a step of selecting or using transfer software to do so and using or entering an address of said second device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), and sending said data, which may be in email format (col 3 lines 48-56); given such a format, it is assumed that the data may comprise any information a user wishes to transfer, including but not limited to text, files, or a

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plurality of addresses. Lastly, the computer and device are not specifically a part of the wireline or wireless networks (see FIGS 1 and 4).

Pepe does not specifically disclose that the portable device and the computer have address databases, and that the data is moved from the first address book to the second.

Microsoft discloses an email program well known in the art at the time of the invention and used in both wireline computers (i.e. the computer of claim 1) and notebook computers (i.e. the portable device) which comprises an address database, and wherein a user may copy information from a file (receivable from e.g. an email) and insert it into their address database (page 6 lines 2-20, page 8 line 1-page 10 line 17). As such, such software may be utilized by the system of Pepe; for example, the computer may send an address book file via email through the network of Pepe to the wireless user, who may then insert the address book including the addresses therein into their email program, inherently storing said addresses in said address database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to the email network of Pepe, as it would allow the use of popular email software used by a very large percentage of world email users on said portable device, for example Microsoft Outlook.

**Regarding claim 11,**

Pepe discloses that the communication can be bi-directional (see FIG 1).

**Regarding claims 13 and 14,**



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Microsoft disclose that said addresses may be in a file (page 6 lines 11-21 and page 8 lines 1-20), and as such selection of a field in the file would further have been obvious to one of ordinary skill in the art as it would not part from the scope of the teachings of Pepe in view of Microsoft.

**Regarding claim 16,**

Since the second device of the invention of Pepe is in part a cellular telephone (col 5 lines 5-30), it is inherent that it would be identified by its telephone number when a data request message is to be sent to it via said messaging protocols.

**Regarding claim 18,**

Pepe discloses a method for transferring information from a computer (22, see FIG 1) inherently using a program, comprising

at said first electronic device, connected to a network (FIG 4), setting up a communication path between it and a second device (30) connected to said network (col 5 lines 14-40 see FIG 3), inherently comprising a step of selecting or using/displaying transfer software to do so and using or entering or requesting an address of said second device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), and sending said data, which may be in email format (col 3 lines 48-56); given such a format, it is assumed that the data may comprise any information a user wishes to transfer, including but not limited to text, files, or a plurality of addresses. Lastly, the computer and device are not specifically a part of the wireline or wireless networks (see FIGS 1 and 4).

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Pepe does not specifically disclose that the portable device and the computer have address databases, and that the data is moved from the first address book to the second and stored there.

Microsoft discloses an email program well known in the art at the time of the invention and used in both wireline computers (i.e. the computer of claim 1) and notebook computers (i.e. the portable device) which comprises an address database, and wherein a user may copy information from a file (receivable from e.g. an email) and insert it into their address database (page 6 lines 2-20, page 8 line 1-page 10 line 17). As such, such software may be utilized by the system of Pepe; for example, the computer may send an address book file via email through the network of Pepe to the wireless user, who may then insert the address book including the addresses therein into their email program, inherently storing said addresses in said address database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to the email network of Pepe, as it would allow the use of popular email software used by a very large percentage of world email users on said portable device, for example Microsoft Outlook.

**Regarding** claims 19 and 20,

Microsoft disclose that said addresses may be in a file (page 6 lines 11-21 and page 8 lines 1-20), and as such selection of a field in the file would further have been obvious to one of ordinary skill in the art as it would not part from the scope of the teachings of Pepe in view of Microsoft.

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8. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe in view of Microsoft as applied to claim 10 above, and further in view of Günlük, of record.

While disclosing all of the limitations set forth in claim 1 as shown above, Pepe in view of Microsoft does not specifically recite that said network may operate according to a hypertext (i.e. internet) protocol or an electronic mail protocol such that a URL or E-mail address is entered rather than a phone number to contact the wireless device.

Günlük discloses that it is useful in a wireless messaging system using, for example, SMS, to allow interoperability, that is, to operate the network such that SMS and other such messaging protocols may be translated into other protocols for messaging interoperability, said other protocols including electronic mail and TCP/IP (i.e. hypertext) (see FIG 2, col 3 lines 55-67). Therefore, it would have been obvious to one skilled in the art to add such a feature to Pepe in view of Microsoft as it would offer a higher performance message routing method, and thus allow better access to the information present in the wireless device.

#### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 10 and 18 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

“Multimedia and Portability Advance in ‘97” and “A Review of Office 97 Professional” disclose that Microsoft Outlook 97 (referred to in the rejections above) was available to the public prior to applicant’s filing date.

**11. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)

**Or:**

(703) 305-9508 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

cc

C. Craver  
March 8, 2001



**DWAYNE BOST**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**